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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,348

08/02/2006

Concepcion Gonzalez Bello

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MERCHANT & GOULD PC

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MINNEAPOLIS, MN 55402-0903

EXAMINER

ZUCKER, PAUL A

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

06/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/565,348	GONZALEZ BELLO ET AL.	
	Examiner	Art Unit	
	Paul A. Zucker	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 2-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of 21 March 2008.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Applicant's cancellation of claims 7-12 is acknowledged.
4. Applicant's addition of new claims 13-18 is acknowledged.
5. Claims 1-6 and 13-18 are pending.
6. The rejection under 35 USC § 101, set forth in paragraph 2 of the previous Office Action mailed 21 November 2007 is withdrawn in response to Applicant's amendment.
7. The rejections under 35 USC § 112, second paragraph, set forth in paragraphs 3 – 6 of the previous Office Action mailed 21 November 2007 are withdrawn in response to Applicant's amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 6 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Frederickson et al (Journal of Organic Chemistry, 1999, 64, pages 2612-2613). Frederickson discloses (Page 2613, column 1, Scheme 2)

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the compound **10** which corresponds to an instantly claimed compound of formula (1) in which $R^1 - R^7 = H$. Frederickson discloses (Page 2613, columns 1 and 2, top, Table 1) the use of pharmaceutical solutions of this compound as dehydroquinase inhibitors. Frederickson therefore anticipates claims 1 and 6.

Examiner's Response to Applicants' Remarks Regarding This Rejection

9. Applicants' argue that R^2 in the amended claims cannot be H. The Examiner disagrees since the amendment does not change the definition of R^2 .

Applicant's arguments filed 21 March 2008 have been fully considered but they are not persuasive for the reason given above.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 13-18 are finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no apparent support for the "administering" of compounds of the invention.

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11. Claims 13-17 are finally rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for use of compounds of the invention as herbicides, does not reasonably provide enablement for any biological or medical use of the compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and /or use the invention commensurate in scope with these claims.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- a. the breadth of the claims: In the instant case the claims are extremely broad encompassing the treatment of any tumor, fungal, microbial or viral infection as well as the use of the compounds as an immunosuppressant
- b. the nature of the invention: The instantly claimed invention involves the treatment of a large variety of disease states with specific, unidentified, compounds of the invention and as such would require a large amount of specific information as to which particular disease states are susceptible to treatment with which specific compounds at what dosage levels .

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- c. the state of the prior art: the state of the prior art would not allow one of ordinary skill in the art to speculate successfully as to which disease states might be treatable with any arbitrary compound of the invention. The determination of any given treatment protocol would require selection of a particular compound. The state of the art would not allow this to be done by simple inspection.
- e. the amount of direction provided by the inventor: The inventor provides no guidance whatsoever for any treatment or selection of medicinally active compounds.
- f. the existence of working examples: No working examples are provided.

Based upon the analysis above, the Examiner concludes that undue experimentation is required to make and use the claimed invention.

Claim Objections

- 12. Claims 3 and 5 are finally objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim since claim 3 depends upon both claims 1 and 2 in a non-alternative way and claim 5 depend on both 2 and 4 in a non-alternative way. See MPEP § 608.01(n). Accordingly, claims 3 and 5 have not been further treated on the merits.
- 13. Claims 2 and 4 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. Claims 1-6 and 13-18 are pending. Claims 1, 6 and 13-18 are finally rejected.

Claims 3-6 are finally objected to.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Evonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. Zucker/
Primary Examiner,
Art Unit 1621